

REMARKS

The present application includes pending claims 1-31, all of which remain rejected. Claims 4, 10, 12, 14, 15-22 and 24-31 have been amended to clarify aspects of the inventions.

Claims 1-31 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0072027 ("Haines"), in view of U.S. Patent No. 6,058,106 ("Cudak") and U.S. Patent No. 6,839,848 ("Kirikoshi"). The Applicants respectfully traverse these rejections for at least the reasons previously discussed during prosecution and the following.

As noted in the Manual of Patent Examining Procedure (Revision 7, July 2008), "[t]o establish *prima facie* obviousness of a claimed invention, **all the claim limitations** must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." See MPEP at 2143.03. Further, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA)." See *id.* (emphasis added). Thus, the MPEP is clear that words of a claim cannot be ignored or disregarded during examination. Instead, **all words in a claim** must be considered during examination.

In response to the previous Amendment, the Examiner states the following:

Applicant has argued that:

The combination of Haines, Cudak and Kirikoshi does not describe, teaches or suggest "associating at least one identifier with said legacy media peripheral, wherein said at least one identifier is used to validate said legacy media peripheral for use at said first geographic location."

Examiner respectfully disagrees with the applicant and still maintains that:

The combination of teaching between Haines, Cudak and Kirikoshi does teach the claimed subject matter that has been addressed in previous action and repeated here again. The new proposed amendment does not change the meaning or merely change the scope of the limitations.

See December 9, 2008 Office Action at page 2.

The Applicants previously demonstrated that the proposed combination of references does not describe, teach or suggest “associating at least one identifier with said legacy media peripheral, wherein said at least one identifier is used to validate said legacy media peripheral for use at said first geographic location.” Much like the previous Office Action, the current Office Action cites **Haines at ¶¶ [0009], [0085] and [0086]** as disclosing these limitations. See December 9, 2008 Office Action at page 3. However, the Applicants previously demonstrated that none of these paragraphs, which the Office Action explicitly relies on, describes, teaches or suggests the relevant claim limitations. In response to the Applicants demonstrating that the portions of Haines relied on by the Office Action do not, in fact, describe, the relevant limitations, the current Office Action summarily notes, **without supporting citations from the references**, that the “combination of teaching between Haines, Cudak and Kirikoshi does teach the claimed subject matter that has been addressed in previous action and repeated here again.” See December 9, 2008 Office Action at page 2. As such, the Applicants once again demonstrate below that the only portions of the cited references that the Office Action relies on, namely **Haines at ¶¶ [0009], [0085] and [0086]**, do not describe, teach or suggest “associating at least one identifier with said legacy media

peripheral, wherein said at least one identifier is used to validate said legacy media peripheral for use at said first geographic location.” **If the Examiner persists in this rejection, the Applicants respectfully request that the Advisory Action specifically cite and quote from the cited references as to where the limitations are allegedly disclosed so that the Applicants can address the specific citations in an Appeal Brief.**

The current Office Action also states the following:

In response to applicant’s argument that there is no suggestion to combine the references....

See December 9, 2008 Office Action at page 2. The Applicants note, however, that neither the July 15, 2008 Amendment, nor the September 19, 2008 Supplemental Amendment explicitly set forth such an argument. Thus, the Applicants are perplexed by this statement in the Office Action. Nevertheless, the Applicants do not concede that the combination of Haines, Cudak and Kirikoshi is necessarily proper. Indeed, the Applicants reserve the right to pursue this argument if an Appeal is necessary.

The Applicants now turn to the claim rejections, in particular. With respect to claim 1, the Applicants submit that the combination of Haines, Cudak and Kirikoshi does not describe, teach or suggest “associating at least one identifier with said legacy media peripheral, wherein said at least one identifier is used to validate said legacy media peripheral for use at said first geographic location.” Once again, **the Office Action cites Haines at ¶¶ [0009] and [0085]-[0086] as disclosing these limitations.** See December 9, 2008 Office Action at page 3. Thus, the Applicants will, once again,

address each of these cited paragraphs and explain that they do not describe, teach or suggest the relevant claim limitations.

First, Haines states the following:

In accordance with another aspect of the present invention, an article of manufacture includes a computer usable medium having computer readable code embodied therein. The computer readable code is configured to cause a processor to determine that a status change has occurred in the peripheral device, *combine a unique device identifier relevant to the peripheral device with the status change to form an electronic message* and transmit the electronic message from an embedded web server contained in the peripheral device across a firewall.

Haines at ¶ [0009] (emphasis added). This cited portion of Haines only discloses that a “unique device identifier” is combined with a status change to form an electronic message. However, neither this cited portion, nor the remainder, of Haines describes, teaches or suggests “associating at least one identifier with said legacy media peripheral, wherein said at least one identifier **is used to validate said legacy media peripheral for use at said first geographic location,**” as recited in claim 1. If this rejection is maintained, the Applicants respectfully request that the Examiner specifically cite and quote from this (or any other) portion of Haines with respect to where the relevant claim limitations are allegedly disclosed.

Next, Haines states the following:

The embedded web server 26 of FIG. 1 then combines a device identifier with the detected consumable or maintenance threshold status in a step S62. In one embodiment, the device identifier comprises a serial number of the peripheral device. In this embodiment, the vendor has previously associated this serial number with other data,

such as the identity and physical address of the owner or user of the peripheral device.

In one embodiment, the device identifier comprises an account number that was assigned to the peripheral device during the process P2. In one embodiment, the account number was stored in the embedded web server 26 of the peripheral device 14. In one embodiment, a group of similar devices having a common user or owner, or maintainer, may share an account number.

Id. at [0085]-[0086]. This portion of Haines discloses that a device identifier, which includes a serial number of a peripheral device, is combined with a detected consumable or maintenance threshold status. The serial number is previously associated with the identity and physical address of a user of the device. The device identifier may also include an account number, which may be shared by a group of similar devices.

While this cited portion of Haines discloses that the serial number may be associated with the identity and address of a user, there is nothing in Haines that describes, teaches or suggests that the device identifier is used to validate use of the device at a particular location. That is, neither the cited portions, nor the remainder, of Haines describes, teaches or suggests “associating at least one identifier with said legacy media peripheral, wherein said at least one identifier **is used to validate said legacy media peripheral for use at said first geographic location,**” as recited in claim 1. Again, if this rejection is maintained, the Applicants respectfully request that the Examiner specifically cite and quote from this (or any other) portion of Haines with respect to where the relevant claim limitations are allegedly disclosed.

The previous and current Office Actions do not show that either Cudak or Kirikoshi makes up for the deficiencies of Haines noted above. Thus, the Applicants respectfully submit that the Office Action has not shown that the proposed combination of references describe, teach or suggest all the limitations of claim 1. For at least these reasons, a *prima facie* case of obviousness has not been established with respect to the pending claims.

Indeed, the Applicants respectfully submit that independent claim 1 is not rendered unpatentable over the proposed combination of references. Independent claims 11 and 21 recite similar limitations to those noted above. Therefore, the Applicants submit that claims 1, 11, 21 and the claims that depend therefrom are allowable over the cited references.

In general, the Office Action makes various statements regarding the pending claims 1-31 and the cited references, which are now moot in light of the above. Thus, the Applicants will not address such statements at the present time. However, the Applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statement should become relevant by appearing in a rejection of any current or future claim or in an Examiner's Answer to an Appeal Brief).

If the Examiner has any questions or the Applicants can be of any assistance, the Examiner is invited to contact the undersigned attorney. Indeed, the Applicants encourage the Examiner to contact the undersigned attorney with any ideas for potential amendments. Such an amendment may render the possibility of an Appeal moot.

The Commissioner is authorized to charge any necessary fees, or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Account No. 13-0017.

Respectfully submitted,

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